REMARKS

Applicants respectfully request favorable reconsideration and a Notice of Allowance.

Claims 1-25 remain pending. Claims 2, 11-13, and 15-21 stand withdrawn from consideration. (Applicants courteously solicit reconsideration of the requirement for restriction and rejoinder of the withdrawn claims.)

Applicants acknowledge with appreciation the Examiner's care in reviewing the prior Information Disclosure Statements. A further submission to assure the information is brought out in this record for the Examiner's careful, independent consideration and review is being concurrently filed.

Applicants acknowledge the Examiner's request for certified translations of the priority documents and consideration of same is being made. The Examiner's patience in this regard will is appreciated.

Applicants note that the Examiner has commissioned certified translations of foreign language references. An Allowance is respectfully solicited along with such translations. If that is not to be the case, then Applicants respectfully suggest that the next Official Communication be non-final so as to afford them a fair opportunity to consider the translations as appropriate.

Claim 3 is definite.

Claim 3 is definite and satisfies the requirements of 35 U.S.C. §112(¶2). There is no statutory requirement for an integer value or other numeric limitation on "high" molecular weight. A person who is skilled in the art understands the concept of "high" molecular weight.

Claim 3 recites "[a] carbon nanotube composition according to claim 1 or claim 2, wherein the carbon nanotube composition additionally contains a high molecular weight compound (d)." A person skilled in the art to which the invention pertains would understand the metes and bounds of the invention as claimed. Such a person would refer to the present specification and be taught that there is no particular limitation on the high molecular weight compound herein, provided that it can be dissolved or dispersed – such as in an emulsion formulation – in the solvent to be used. The specification at pages 44-45 further informs the person skilled in the art that:

> specific examples of which include polyvinyl alcohols such as polyvinyl alcohol, polyvinyl formal and polyvinyl butyral; polyacrylamides such as polyacrylamide, poly(N-t-butylacrylamide and polyacrylamide methyl propane sulfonate; polyvinyl pyrrolidones; polystyrene sulfonates and their sodium salts; cellulose, alkyd resin, melamine resin, urea resin, phenol resin, epoxy resin, polybutadiene resin, acrylic resin, urethane resin, vinyl ester resin, urea resin, polyimide resin, maleic acid resin, polycarbonate resin, vinyl acetate resin, chlorinated polyethylene resin, chlorinated polypropylene resin, styrene resin, acrylic/styrene copolymer resin, vinyl acetate/acrylic copolymer resin, polyester resin, styrene/maleic acid copolymer resin, fluororesin and their copolymers. In addition, these high molecular weight compounds (d) may be used as a mixture of two or more types at an arbitrary ratio.
>
> Among these high molecular weight compounds (d), water soluble high molecular weight compounds or high molecular weight compounds that form an emulsion in aqueous systems are used preferably in consideration of solubility in solvent, stability of the resulting composition and electrical conductivity, and high molecular weight compounds having an anion group are used particularly preferably. In addition, among these, those used by mixing one or two or more types of aqueous acrylic resin, aqueous polyester resin, aqueous urethane resin and aqueous chlorinated polyolefin resin are used preferably.

Claims 1, 3 and 22-25 define novel inventions over US2002/0161101 to Carroll.

Claims 1, 3 and 22-25 refer to a conducting polymer whereas the Carroll reference does not disclose and does not describe a conducting polymer. This follows from Carroll at, for

instance, paragraphs [0065]-[0066]. Applicants appreciate the citation to such paragraphs in the Office Action but it appears to Applicants that the Office Action may have mistakenly over-read the paragraphs in question. Applicants courteously suggest that novelty is corroborated since Carroll apparently neither discloses nor suggests a conducting polymer and the dispersion effects that are achievable by practicing the present invention.

Claims 1, 8 and 22-25 are novel over US 2003/012111 to Glatkowski.

Even if, *arguendo*, Glatkowski is prior art under 35 U.S.C. 102(e), claims 1, 8 and 22-25 define novel unobvious inventions.

Claims 1, 3 and 22-25 refer to a conducting polymer whereas the Glatkowski reference does not disclose and does not describe a conducting polymer. The Glatkowski reference mentions a polyimide in paragraph [0048] but that does not describe the conducting polymer component in Applicants' claims 1, 3 and 22-25. Applicants appreciate the citation to paragraphs [0052]-[0053] and [0088]-[0089] in the Office Action but it appears to Applicants that the Office Action may have mistakenly over-read the paragraphs in question. It would seem from the aforementioned paragraphs that N-methyl-pyrrolidone is used in making a solution, not water as suggested in the Office Action. The Glatkowski reference does not disclose and does not describe Applicants' formula (5). Applicants courteously suggest that novelty is corroborated since Glatkowski apparently neither discloses nor suggests a conducting polymer and the dispersion effects that are achievable by practicing the present invention.

Claims 1 and 22-25 are define novel inventions over WO 03/013199 to Eikos.

Even if, *arguendo*, Eikos is prior art under 35 U.S.C. §102(a) or §102(e), claims 1 and 22-25 define novel, unobvious inventions.

Claims 1 and 22-25 refer to a conducting polymer whereas the Eikos reference does not disclose and does not describe a conducting polymer. The Eikos reference mentions some polymeric materials, but in the passages on page 10 cited in the Office Action do not concern a conductive polymer. The Eikos reference may appear to mention a Ceromer coating of some kind – such as at page 19, Table 2, which may seem to be a polymer of hybrid materials (organic polymer and inorganic materials), but that is not a silane coupling agent, which is typically a lower molecular weight moiety. The Eikos reference does not suggest improving moisture resistence in a composition or in a coated composition through the use of a silane.

Claim 5 defines an unobvious invention over Glatkowski.

Claim 5 refers to "[a] carbon nanotube composition according to any one of claims 1 to 4, wherein the carbon nanotube composition additionally contains a surfactant (f)." The invention would not have been obvious to a person of only ordinary skill in the art in view of the Glatkowski reference. Applicants respectfully submit the rejection can be favorably reconsidered and withdrawn inasmuch as the Glatkowski reference does not describe and would not have suggested the conducting polymer component in Applicants' claims to a person of only ordinary skill in the art for reasons discussed above as to claim 1.

Claims 4-5, 8-10 and 14 define unobvious inventions over Carroll in view of JP2002-140930.

Applicants respectfully submit that the references would not have been combined by a person of only ordinary skill in the art, and furthermore even if, arguendo, the Carroll and JP '930 references were combined, they would not have taught the inventions of claims 4-5, 8-10 and 14 to a person of ordinary skill in the art.

The combination with the asserted obviousness reflects unfortunately, legally proscribed hindsight. As the late Judge Rich, who is widely recognized as a co-author of the 1952 patent statute, once explained:

> Slight reflection suggests, we think, that there is usually an element of "obviousness to try" in any research endeavor, that it is not undertaken with complete blindness but rather with some semblance of a chance of success, and that patentability determinations based on that as the test would not only be contrary to statute but result in a marked deterioration of the entire patent system as an incentive to invest in those efforts and attempts which go by the name of "research."

In re Tomlinson, 150 U.S.P.Q. (BNA) 623, 626 (CCPA 1966).

Applicants respectfully rely upon their prior traverse as to the Carroll reference and acknowledge with appreciation the candid statement in the Office Action that the Carroll reference does not explicitly disclose the presence of a surfactant, a basic compound and a conducting polymer of formula (5). The JP '930 document does not suggest carbon nanotubes nor does it suggest that whatever it is that is disclosed would have been combined by a person of ordinary skill in the art with carbon naontubes. The different references do not seem to teach the same purpose, which undermines a premise in the Office Action. Therefore, the combination would not have been made, and would not have taught the invention to a person of ordinary skill in the art.

Claims 4, 8-10 and 14 define unobvious inventions over Carroll in view of JP2000-219739 (JP '739).

Applicants refer to their immediately above traverse and also submit that the differently applied JP '739 by happenstance has an apparent patina of relevancy to the present inventions but upon scratching the surface the relevancy is removed. For instance, the Office Action apparently considers JP '739 at page 9 paragraphs [0039] to [0040] to disclose a basic compound

but upon inspection it is not the "basic compound" as recited in the present composition. There would seem to be a difference between manufacturing a polymer as in JP '739 and the basic compound as an ingredient in a composition. The former does not suggest the latter. In addition, the short comings of the Carroll reference are elsewhere not overcome by the JP '739 referenc3. As another example, JP '739 does not disclose or suggest carbon nanotubes, nor the dispersion effects obtainable in accordance with the present invention, which support unobviousness.

Claims 3-5, 9-10 and 14 define unobvious inventions
Over the Glatkowski reference in view of the JP '930 Reference.

Applicants refer to their prior traverses with respect to the Glatkowski reference and also submit that the differently applied JP '930 does not supply the evidence – facts, teachings, and suggestions – missing from the primary reference as explained hereinabove in traverses against other references.

Claims 4, 9-10 and 14 define unobvious inventions
Over the Glatkowski reference in view of the JP '739 Reference.

Applicants refer to their prior traverses with respect to the Glatkowski reference and also submit that the differently applied JP '739 does not supply the evidence – facts, teachings, and suggestions – missing from the primary reference as explained hereinabove in traverses against other references.

Claim 6 defines an unobvious invention over
Any of the Carroll, Glatkowski or Eikos Reference
In View of WO 03/13199 and the Nguyen Reference.

Applicants submit that simply finding individual elements spread amongst various prior art references does not make their combination obvious, nor does it make the claimed inventions obvious to a person of ordinary skill in the art. Applicants respectfully solicit clarification

inasmuch as the rejection seems to treat the Eikos reference (one reference) as two references. In any event, the references would not have been combined and, arguendo, even if combined, they would not have taught the claimed invention to a person of ordinary skill in the art for the reasons of record hereinabove.

Claim 7 defines an unobvious invention over
Any of the Carroll, Glatkowski or Eikos Reference
In View of WO 03/13199 and the Nguyen Reference.

Applicants submit that simply finding individual elements spread amongst various prior art references does not make their combination obvious, nor does it make the claimed inventions obvious to a person of ordinary skill in the art. Applicants respectfully solicit clarification inasmuch as the rejection seems to treat the Eikos reference (one reference) as two references. In any event, the references would not have been combined and, arguendo, even if combined, they would not have taught the claimed invention to a person of ordinary skill in the art for the reasons of record hereinabove.

Lastly, Applicants comment on the 'legal' citations in the Office Action.

It is important to remind oneself that there are no per se rules of obviousness, the Kerkhoven case notwithstanding. This may be seen from the Court's admonitions in concluding its Durden decision:

> We are sure that there are those who would like to have us state some clear general rule by which all cases of this nature could be decided. Some judges might be tempted to try it. But the question of obviousness under § 103 arises in such an unpredictable variety of ways and in such different forms that it would be an indiscreet thing to do. Today's rule would likely be regretted in tomorrow's case. Our function is to apply, in each case, §103 as written to the facts of disputed issues, not to generalize or make rules for other cases which are unforeseeable. The task may sometimes be easy and

> sometimes difficult; and as this case shows, not all of those required to decide may agree. But such is the way of the "law."

In re Durden, 226 U.S.P.Q. 359, 362 (Fed. Cir. 1985). In a similar vein, the predecessor to the Federal Circuit reversed the Board's "rule" driven analysis and was provoke enough to remark "Oft repeated rules, like oft repeated myths, **seem to** die hard." In re Fay, 146 U.S.P.Q. (BNA) 47 (CCPA 1965).

Conclusion

Applicants have endeavored to respond to the several different rejections of record and believe that their claimed inventions are in condition for a Notice of Allowance. Such Notice is courteously solicited.

Respectfully submitted,

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